

Remarks

Claims 4 through 7 are pending in this application. Claims 1 through 3 were previously cancelled by preliminary amendment. The pending claims stand rejected under 35 U.S.C. §112, second paragraph. This paper contains amendments under 37 C.F.R. §1.121.

Priority

The Office indicates that the specification for any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must include an reference to each prior application including identification by application number or international application number, international filing date, and relationship of the applications. Applicants have amended the specification to include that the application is a national stage entry under 35 U.S.C. §371 of PCT/US2003/032746, filed November 10, 2003 which claims benefit of Provisional Application No. 60/428,892, filed November 22, 2002.

Specification

The Office indicates that the incorporation of essential material (emphasis added) in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other Office imposed requirement. That amendment must be accompanied by a statement indicating the material inserted is material previously incorporated by reference and contains no new matter (37 C.F.R. 1.57(f)). For this application, Applicants assert that the reference at page 2, line 29 through page 3, line 2 and at page 19, lines 28 through 29 involving incorporation by reference of PCT patent application number PCT/US002/11884 is not essential material as defined in 37 C.F.R. 1.57(c):

(c) "Essential material" may be incorporated by reference, but only by way of an incorporation by reference to a U.S. patent or U.S. patent application publication, which patent or patent application publication does not itself incorporate such essential material by reference. "Essential material" is material that is necessary to:

(1) Provide a written description of the claimed invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to

enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and set forth the best mode contemplated by the inventor of carrying out the invention as required by the first paragraph of 35 U.S.C. 112;

(2) Describe the claimed invention in terms that particularly point out and distinctly claim the invention as required by the second paragraph of 35 U.S.C. 112; or

(3) Describe the structure, material, or acts that correspond to a claimed means or step for performing a specified function as required by the sixth paragraph of 35 U.S.C. 112.

Applicants assert that the incorporated reference is not necessary to meet any of the aforementioned requirements under 35 U.S.C. 112. Applicants, therefore, have deleted these references from the specification.

While Applicants do not acquiesce to the Office's assertion that the title of the invention is not descriptive, the title has been amended to hasten prosecution.

In view of the points detailed above, Applicants assert that these issues are obviated.

Rejection of Claim 5 under 35 U.S.C. §112, Second Paragraph

Claim 5 is rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. While Applicants do not acquiesce to the merits of this rejection, Claim 5 has been amended to remove the periods after the first, second, and third species in the claim, replacing them with semi-colons, and to insert the word "and" after the third species. The periods after a, b, c, and d in Claim 5 are maintained since these letters are specifically used to separate and clearly organize the species within the claim and have nothing to do with naming the claimed species. Alternatively, Applicants note that the "[1,5a]" designation in the second species indicates where the two rings, pyrazole and azepine, are fused to each other. This designation, which also is present for the other species within Claim 5, is necessary to properly name the compound. As such, Applicants assert that Claim 5 is neither vague nor indefinite for inclusion of the periods after a, b, c, and d and the "[1,5a]" designation. Applicants further assert that the rejection is obviated and respectfully request withdrawal of this rejection.

Allowable Subject Matter

Applicants note the Office's statement indicating that Claims 4, 6, and 7 are allowed.

Conclusion

Applicants assert that the above-stated remarks overcome the Office's rejection for this application. Applicants courteously solicit reconsideration of this rejection and passage of this case to issuance.

Respectfully submitted,

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